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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/338,729	06/23/1999	DENNIS GROSS	10853/1	1761
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26646 7590 11/26/2001

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EXAMINER

BERMAN, ALYSIA

ART UNIT

PAPER NUMBER

1619

DATE MAILED: 11/26/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/338,729

Applicant(s)

GROSS, DENNIS

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-9,27-30,34 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-26,31-33 and 36-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the amendment filed October 5, 2001. Claims 10, 16, 37, 40 and 41 have been amended. Claims 45 and 46 have been added. Claims 1-46 are pending. Claims 1-9, 27-30, 34 and 35 have been withdrawn as directed to a non-elected invention. The status of claims 10-26, 31-33 and 36-46 are as follows.

Specification

2. The amendment filed October 5, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material that is not supported by the original disclosure is as follows: the compositions are not removed from the skin.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10-26, 31-33 and 36-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

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inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claims now contain a limitation that the compositions are not removed from the skin, which was not disclosed in or supported by the specification as originally filed.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 16-21, 23 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,720,949 (949).

This rejection is maintained for reasons of record in paper no. 8. US '949 discloses a cosmetic mask comprising a first composition and a second composition that are applied sequentially to the face. One of the compositions comprises an acid and the other comprises an effervescent agent (abstract). The effervescent agent is preferably sodium bicarbonate and the acid is an α -hydroxy acid such as lactic acid (col. 2, lines 35-38). The compositions may be applied using a spatula or any other convenient applicator (col. 2, lines 42-47).

The effervescent composition may comprise from about 1-20% of a surfactant system (col. 3, lines 31-33). Surfactants such as cetareths, ceteths, laneths, nonoxynols, octoxynols, glyceryl stearate, PEG-castor oil, poloxamers, poloxamines

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and steareths are disclosed at column 5, line 47 to column 6, line 35. US '949 discloses ethoxylated sorbitan esters with fatty acids or alcohols and ethoxylated esters having preferably 14-18 carbon atoms, which encompassed polysorbate-20 (col. 5, line 60 to col. 6, line 4).

The pH of the effervescent composition is from above 7.5 to about 9, preferably between 7.8 and 8.3 (col. 7, lines 58-60). The pH of the acid composition is from about 3.5 to about 6 (col. 8, lines 50-64). As a further note, pH is an inherent property of an acid or alkaline agent. Therefore, the pH of a composition comprising an acid or an alkaline agent is inherently either acidic or basic, respectively, unless specifically altered.

For additional suitable acids see column 9, lines 8-13. See Example 1 at column 12 for one composition comprising 5.0 wt.% sodium bicarbonate, 1.5% glyceryl stearate, 5.0% cetyl alcohol, 1.5% PEG-100 stearate and 1.5% PEG-40 castor oil with a pH of 8.0 and another composition comprising 9.1% lactic acid with a pH of 4.9. The reference teaches at column 13, lines 7-9 that the composition bubbles because of the reaction between the effervescent agent and the acid thereby neutralizing the acid component.

7. Claims 16-21 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/22078 using US 6,171,347 B1 (347) as an English language equivalent for citation purposes.

This rejection is maintained for reasons of record in paper no. 8. US '347 discloses a multi-component kit comprising a first composition for oxidative dyeing of hair

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and a second reducing composition with a pH of 1.8-6. The reducing composition comprises an acid such as α -hydroxycarboxylic acids. See claim 18. See Examples 1.1-1.5 bridging columns 11 and 12 for an oxidative hair dye composition comprising sodium hydroxide, sodium lauryl ether sulfate and ammonia and stripper gel compositions (reducing compositions) comprising ascorbic acid, *inter alia*. US '347 discloses at column 11, lines 64-65 that the oxidative hair dye composition is applied with an artist's brush. For the pH value of the oxidative dye composition preferably from 5 to 9, see column 9, lines 7-8. This either overlaps or encompasses the pH ranges instantly claimed. US '347 discloses at column 9, lines 14-16 that buffers such as alkali carbonates can be added to the compositions. For surfactant/emulsifiers, see column 8, lines 52-57.

8. Claims 16-23 and 46 are directed to products. The future intended use of the product does not provide patentability to the product over the prior art. Therefore, the limitations stating that the compositions are not rinsed or removed from the skin are not given patentable weight since these limitations are dependent on application.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,720,949 (949).

This rejection is maintained for reasons of record in paper no. 8.

11. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,720,949 (949) in combination with US 4,797,273 (273) and Database REGISTRY on STN for polysorbate-20.

This rejection is maintained for reasons of record in paper no. 8.

12. Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,720,949 (949) in combination with US 5,242,433 (433).

This rejection is maintained for reasons of record in paper no. 8.

13. Claims 16-21, 41, 42 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/22078 (078) using US 6,171,347 B1 (347) as an English language equivalent in combination with US 5,242,433 (433).

This rejection is maintained for reasons of record in paper no. 8.

14. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/22078 using US 6,171,347 B1 (347) as an English language equivalent in combination with US 5,304,370 (370).

This rejection is maintained for reasons of record in paper no. 8.

Response to Arguments

15. Applicant's arguments filed October 5, 2001 have been fully considered but they are not persuasive.

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16. Applicant argues that the compositions of US '949 are not suitable for application with a pad. This argument is not commensurate in scope with broadest independent claims. Claims 16 and 46 do not require pads. Additionally, although US '949 specifically mentions a spatula for application of the compositions, it also states that any other convenient applicator may be used. It is known in the art to use pads to apply various types of cosmetic compositions to the skin and hair. This limitation is not considered critical to the invention.

17. Applicant argues that because the compositions of US '949 form a mask that must be removed from the skin one skilled in the art seeking to develop Applicant's particular kit would not even be motivated to look to Davis for guidance. The rejected claims are directed to a product. Any limitations directed to a future intended use such as removal of the product after application are not given patentable weight over the prior art product. There are no limitations in the instant kit claims that distinguish over the prior art. Both the instant claims and the prior art contain two compositions, one of which is acidic and one of which is alkaline and a means for applying the compositions.

18. Applicant argues that WO '078 does not teach or suggest dermatological compositions. The instant kit claims are directed to a product. The preamble of the claims does not provide patentability. See *In re Tuominen*, 213 USPQ 89 and *In re Pearson*, 181 USPQ 641. Pearson stated that a known composition cannot be patented solely on preamble use. The compositions of the instant claims and the prior art contain the same components and, therefore, could be used for the same purpose regardless of

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what is disclosed as the intended use by either the instant claims or the prior art. There are no limitations in the instant claims that distinguish over the prior art.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

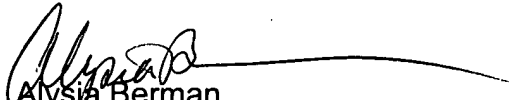
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

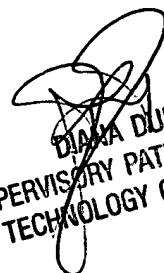
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached during core hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3704 or 703-305-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
November 17, 2001


DIANA DUDASH
SUPERVISORY PATENT EXAMINER
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